

Appl. No.: 10/025,280  
Response dated October 14, 2003  
Office Action 7/16/2003

### **REMARKS**

#### **Support for New Claims**

Applicants' new claims find support in the specification and claims as filed, in particular paragraphs [0106] and [0098] that recite the pH range recited in new claim 16.

#### **Claim Rejections under 35 USC § 112**

The Action rejects the claims under Section 112, second paragraph for being indefinite. Applicants believe that the claims as amended address each and every ground for rejection, namely, an error in the amendment that was lacking the required weight to ratio reference. All pending claims are therefore allowable and Applicants respectfully request withdrawal of all pending rejections.

#### **Claims Rejections under 35 USC § 103**

Claims 1-12 stand rejected for obviousness over DeSimone ('005) in light of Schlenker ('825). In order to establish a prima facie case of obviousness, the prior art must teach or suggest to one of ordinary skill in the art to make the claimed compositions or device or how to carry out the claimed invention. In addition, the prior art must also reveal to one of ordinary skill in the art that the claimed compositions, device or process would also have a reasonable expectation of success. Both the suggestion and the reasonable expectation of success must be found in the prior art and not in the applicant's disclosure. See *in re Dow Chemical Co.*, U.S.P.Q.2d (BNA) 1529 (Fed Cir. 1988); *in re Vaeck*, 20 U.S.P.Q.2d (BNA) 1238 (Fed. Cir. 1991).

Both of the Actions in the present case states that:

DeSimone et al do not specifically teach the use of a hydrophilic fluorescent agent such as distyrylbiphenyl derivative or a dry cleaning composition containing densified carbon dioxide, a polar solvent, surfactant, hydrophilic fluorescer such as a distyrylbiphenyl derivative, and the other requisite components of the composition in the specific proportions as recited by the instant claims. (Emphasis added) (Action of 7/16/03, page 5; Action of 2/6/03, page 7).

The Action cites Schlenker to add the element missing, namely, "the use of a hydrophilic whitening agent..." However, the Action cites only to the Abstract of Schlenker, whose

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invention is directed to a "[p]rocess for the fluorescent whitening of hydrophobic textile materials, especially polyesters, wherein the textile material is treated with disperse fluorescent whitening agents in supercritical CO<sub>2</sub>."

Schlencker, et al., however, teach the exact opposite of the proposition made in the Action, namely, the use of "water-insoluble compounds" as the whitening agent. Water-insoluble compounds are those that are not water-loving, that is, they are hydrophobic. The claims of the present invention are directed to a hydrophilic fluorester that is an element of each and every claim of the present invention.

For example, the Schlencker patent states:

The process according to the invention intends to use, instead of the aqueous liquors described above, whitening liquors in which the water has been replaced by supercritical carbon dioxide, i.e. CO<sub>2</sub> whose pressure and temperature are above the critical pressure and the critical temperature. The viscosity of this supercritical CO<sub>2</sub> is approximately that of the corresponding gas and its density is approximately comparable to that of the correspondingly liquefied gas. (Emphasis added) (Col. 1, ll. 32-40).

A further advantage of the process according to the invention is that it is possible to use disperse fluorescent whitening agents which exclusively consist of the actual whitening agent and do not contain the customary dispersants and diluents. (Emphasis added) (Col. 1, ll. 61-65).

The fluorescent whitening agents used in the process according to the invention are water-insoluble compounds containing two identical or different radicals selected from the group consisting of styryl, stilbenyl, naphthotriazolyl, benzoxazolyl, coumarin, naphthalimide, pyrene and triazinyl which are linked to one another directly or via a bridging member selected from the group consisting of vinylene, styrylene, stilbcnylene, thienylene, phenylene, naphthylene and oxadiazolylene. (Emphasis added). (Col. 1, l. 66-Col. 2, l. 7).

Therefore, Schlencker fails to provide the additional disclosure required by 35 U.S.C. §103, that is, a disclosure with, both: a suggestion (use of a hydrophilic whitener) and the reasonable expectation of success that must be found in the prior art and not in the applicant's disclosure. in re Vaack, 20 U.S.P.Q.2d (BNA) 1238 (Fed. Cir. 1991). The "water-insoluble compounds" of

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Schlencker fail to meet a key limitation of the present invention (the "hydrophilic fluorescer") and neither disclosure teaches, suggests or motivates how: (1) the combination of DeSimone and Schlenker would include each and every element of the claimed invention; (2) provide any expectation of success; and/or (3) how one or either reference could be modified to achieve the present invention as claimed or a successful functioning invention. Therefore, all pending claims are therefore allowable and Applicants respectfully request withdrawal of all pending rejections.

No additional claims' fees are believed to be due as a result of the addition of the new claims on this Response. The Examiner is invited to telephone the undersigned at the telephone number listed below if he or she has any questions or suggested amendments to the claims.

Dated this October 14, 2003.

Respectfully submitted,

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